Docket No.: 0142-0355P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Roger BERGS et al.

Application No.: 09/878,962 | Confirmation No.: 3480

Filed: June 13, 2001 | Art Unit: 2194

For: Technology for processing information e.g. representing print requests in networked environment a system suitable for applying this method, and a | Examiner: L. Truong

SUPPLEMENTAL APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Notice of Non-compliant Appeal Brief, this Supplemental Appeal Brief is filed herewith. Applicants acknowledge with appreciation the telephone discussion between the Appeals Clerk and Applicants' representative on March 24, 2008. During the telephone discussion, the clerk clarified the basis for the Notice of Non-compliant Appeal Brief. Applicants' original Appeal Brief is amended as suggested by the clerk during the telephone discussion of March 24, 2008.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.2:

I.	Real Party In Interest
II	Related Appeals and Interferences
III.	Status of Claims
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V.	Summary of Claimed Subject Matter
VI.	Grounds of Rejection to be Reviewed on Appeal
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I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

OCÉ-TECHNOLOGIES B.V.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 41 claims pending in application.

B. Current Status of Claims

Claims 1-2, 4-22 and 24-43 are pending in the present application. Claims 1, 18, 21 and 35 are independent claims. Claims 1, 2, 4, 8-22, 24-25 and 30-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman et al. (U.S. Patent No. 6,469,796, hereinafter Leiman) in view of Motamed et al. (U.S. Patent No. 7,081,969, hereinafter Motamed) and DeHority (U.S.

Patent No. 5,129,639); claim 43 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman, Motamed and DeHority in view of Beck (U.S. Patent No. 6,275,299); and claims 5-7 and 26-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman, Motamed, DeHority and Applicants' disclosed related Art (ADRA).

C. Claims On Appeal

Independent claims 1, 18, 21 and 35 are the subject of the present appeal.

IV. STATUS OF AMENDMENTS

Applicant's amendment under 37 C.F.R. §1.111 of March 15, 2007 and Applicant's reply under 37 C.F.R. §1.116 of October 19, 2007 have been entered. No further amendments await disposition.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is directed to

> A method of processing information with a system provided with a plurality of processing devices coupled to a network,[1] the method comprising:
>
> receiving a definition of a job for processing information from a user of the system;[2]
>
> automatically checking whether all processing devices belonging to a predetermined set selected from the plurality of processing devices are suitable for performing the job;[3]
>
> presenting an indication for each processing device of the set, to the user via presentation means, of whether the same is suitable for performing the job;[4]
>
> if a processing device among the processing devices belonging to the set is not suitable for performing the job, then a reason for this is indicated via the presentation means;[5]

[1] Specification, Fig. 1, items 12-14.
[2] Specification, page 7, lines 18-22.
[3] Specification, page 7, lines 29-30.
[4] Specification, page 7, lines 33-34.
[5] Specification, page 8, lines 1-4.

after that, selecting a processing device out of all processing devices belonging to the set, wherein the processing device not suitable for the job is selectable to become the selected processing device;[6] and

transmitting at least a part of the job to the selected processing device.[7]

Claim 18 is directed to

A method of processing information with a system comprising one processing device and presentation means,[8] the method comprising:

receiving a definition of a job for processing information from a user of the system;[9]

automatically checking whether the processing device is suitable for performing the job;[10]

indicating, if the processing device is not suitable for performing the job, a reason why the processing device is not suitable for performing the job via the presentation means;[11] and

after that, selecting the processing device, wherein the processing device not suitable for the job is selectable to become the selected processing device for performing the job.[12]

Claim 21 is directed to

A system for processing information, the system comprising:

a network[13] to which are coupled the following;

a plurality of processing devices;[14]

defining means for defining a job for processing information;[15]

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[6] Specification, page 8, lines 23-33.
[7] Specification, page 9, lines 26-28.
[8] Specification, Fig. 1, items 3 (display) and 6 (control module).
[9] Specification, page 7, lines 18-22.
[10] Specification, page 7, lines 29-30.
[11] Specification, page 8, lines 1-4.
[12] Specification, page 8, lines 23-33.
[13] Specification, Fig. 1, item 16.
[14] Specification, Fig. 1, items 12-14.
[15] Specification, Fig. 1, item 9.

research means[16] for checking whether all processing devices belonging to a predetermined set selected from the plurality of processing devices are suitable for performing the defined job;

presentation means for presenting an indication,[17] for each processing device of the set, of whether the same is suitable for performing the defined job, and if a processing device among the processing devices belonging to the set is not suitable for performing the job, indicating why said processing device is not suitable; and

selection means[18] for selecting a processing device out of all processing devices belonging to the set based on the indication, wherein the processing device not suitable for the job is selectable to become the selected processing device.[19]

Claim 35 is directed to

A system for processing information,[20] the system comprising:

a processing device;[21]

defining means for defining a job for processing information;[22]

research means for checking whether the processing device is suitable for performing the defined job;[23] and

indicating means to indicate a reason, in the event that the research means shows that the processing device is not suitable for performing the job, why said processing device is not suitable for performing the job,[24] wherein the processing device not suitable for the job is selectable to become a selected processing device for performing the job.[25]

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[16] Specification, Fig. 1, item 8.
[17] Specification, Fig. 1, items 3 and 6; see also page 4, line 27.
[18] Specification, Fig. 1, item 10.
[19] Specification, page 8, lines 23-33.
[20] Specification, Fig. 1.
[21] Specification, Fig, 1, items 12-14.
[22] Specification, Fig. 1, item 9.
[23] Specification, Fig. 1, item 8.
[24] Specification, Fig. 1, items 3 and 6; see also page 4, line 27.
[25] Specification, page 8, lines 23-33.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are whether claims 1, 18, 21 and 35 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman in view of Motamed and DeHority. Within these grounds of rejection to be reviewed are two issues:

The first issue is whether any rejection based on Leiman is proper based on a finding that Leiman teaches away from Applicant's claimed invention.

The second issue is whether Motamed cures admitted deficiencies in the teachings of Leiman and discloses selecting a processing device out of all processing devices belonging to the set, wherein the processing device not suitable for the job is selectable to become the selected processing device.

VII. ARGUMENT

A. Claims 1, 18, 21 and 35 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman in view of Motamed and DeHority.

1. Leiman Is An Improper Reference Upon Which To Base A Rejection Because Leiman Teaches Away From Applicant's Claimed Invention

As acknowledged by the Official Action,[26] Leiman and Motamed each do not disclose or suggest Applicant's claimed feature of "wherein the processing device not suitable for the job is selectable to become the selected processing device," recited in pending claims 1 and 18. To cure this deficiency, the Official Action applies DeHority. However, regardless of the teachings of DeHority (or Motamed), Applicant submits that the proposed combination of Leiman and DeHority (or Motamed) is improper.

In KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1740 (2007), the Court noted

> "In United States v. Adams, 383 U. S. 39, 40 (1966), a companion case to Graham, the Court considered the obviousness of a "wet battery" that varied from

[26] Official Action of June 19, 2007, paragraph 6.

> prior designs in two ways: It contained water, rather than the acids conventionally employed in storage batteries; and its electrodes were magnesium and cuprous chloride, rather than zinc and silver chloride. The Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result. 383 U. S., at 50–51. It nevertheless rejected the Government's claim that Adams's battery was obvious. The Court relied upon the corollary principle that ***when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.*** Id., at 51–52. When Adams designed his battery, the prior art warned that risks were involved in using the types of electrodes he employed. The fact that the elements worked together in an unexpected and fruitful manner supported the conclusion that Adams's design was not obvious to those skilled in the art."

Leiman describes

> To perform an operation on a job, the operator selects the job in the Job Queue Status table by clicking the left mouse button on the desired job and selects the desired operation from the Operations menu 182 (FIG. 19). The operations include Hold, Release, Delete, Copy, Change Priority, Change Retention Time, Change Class, Print, and Report Queue. The Hold option allows the operator to put a print job on hold, and the Release option allows the operator to change the status of a print job to ready. When a print job has a ready status, the operator may print the job by selecting the print option and a desired printer from a Print Panel 184 (FIG. 20) or by moving the cursor over the job in the Job Queue Status table, pressing the left mouse button down, and dragging-and-dropping the print job onto the desired printer icon (i.e., drag-and-drop technology). ***If the print job set-up does not match the printer set-up, for example, the form required for the print job is not loaded on the printer, then the GUI indicates that the print job cannot be printed on the selected printer by not allowing the print option to be selected or by not allowing the print job to be dropped onto the printer icon.***[27]

Thus, Leiman explicitly describes that a processing device not suitable for the job is prevented from being selectable to become the selected processing device, which is the exact opposite of Applicant's claimed feature of the processing device not suitable for the job being selectable to become the selected processing device.

Elsewhere, Leiman describes

[27] Leiman, column 7, line 65 - column 8, line 18.

> Implementations of the invention may include one or more of the following. The method may include receiving the print jobs at a print server coupled to the graphical user interface and listing the received print jobs in the graphical user interface. Controlling may include selecting a print job from the list of received print jobs, determining if a printer coupled to the print server has a set-up compatible with the selected print job's set-up, and sending the selected print job from the print server to an output manager connected to the printer. Selecting may include dragging-and-dropping the selected print job from the list of print jobs onto a printer icon, and the method may also include ***preventing the drag-and-drop of the selected print job if the printer set-up is determined to be incompatible with the selected print job's set-up***.[28]

Leiman does not disclose any ability for selecting an ***incompatible*** printer. Because Leiman exclusively and explicitly describes ***preventing*** the selection of an incompatible printer, Applicant submits that Leiman teaches away from the invention recited Applicant's pending claims 1 and 18.

For similar reasons, Applicant submits that Leiman teaches away from the selection means of claim 21, where the selection means is for selecting a processing device out of all processing devices belonging to the set based on the indication, wherein ***the processing device not suitable for the job is selectable to become the selected processing device***. Applicant submits that Leiman teaches away from the indicating means of claim 35, where the indicating means is to indicate a reason, in the event that the research means shows that the processing device is not suitable for performing the job, why said processing device is not suitable for performing the job, ***wherein the processing device not suitable for the job is selectable to become a selected processing device for performing the job***.

Because Leiman teaches away from the proposed combination, Applicant submits that all rejections based upon Leiman are improper. Because Leiman is an improper basis upon which to base a rejection, Applicant submits that the invention recited in independent claims 1, 18, 21 and 35 is not *prima facie* obvious.[29]

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[28] Leiman, column 2, lines 27-41.

[29] MPEP 2145(X)(D)(2) – "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst which

2. Motamed does not disclose "selecting a processing device out of all processing devices belonging to the set, wherein the processing device not suitable for the job is selectable to become the selected processing device."

As acknowledged by the Official Action,[30] Leiman does not disclose or suggest "selecting a processing device out of all processing devices belonging to the set" as recited in claims 1 and 18. To cure this deficiency, the Official Action applies Motamed.

Applicant submits that the Official Action improperly evaluates the feature in question. That is, the feature in question does not just recite "selecting a processing device out of all processing devices belonging to the set" but instead recites "selecting a processing device out of all processing devices belonging to the set, wherein the processing device not suitable for the job is selectable to become the selected processing device." In reading the feature in its entirety, the full scope of the feature becomes clear.

Motamed does not disclose or suggest "selecting a processing device out of all processing devices belonging to the set, ***wherein the processing device not suitable for the job is selectable to become the selected processing device***." Instead, Motamed describes

> Errors often occur with printers. Thus, within a cluster of printers ***a user may set for automatic rerouting of a print job to another printer if the first selected printer is unable to perform a print job.*** A user may also specify a timeout period before the job is rerouted. In that way the user is given time to fix the problem. This is helpful when the printer problem can be easily fixed, for example where there is a paper jam or the printer is out of paper.[31]

Thus, while Motamed describes selecting another printer, Motamed does not disclose or suggest selecting an unsuitable printer as recited in Applicant's claims 1 and 18. For similar reasons,

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contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.)."

[30] Official Action of June 19, 2007, paragraph 4.

[31] Motamed, column 3, lines 35-42.

Motamed does not cure the deficiencies of Leiman relative to independent claims 21 and 35. That is, like Leiman, Motamed does not disclose or suggest a) selection means for selecting a processing device out of all processing devices belonging to the set based on the indication, ***wherein the processing device not suitable for the job is selectable to become the selected processing device***; or b) indicating means to indicate a reason, in the event that the research means shows that the processing device is not suitable for performing the job, why said processing device is not suitable for performing the job, ***wherein the processing device not suitable for the job is selectable to become a selected processing device for performing the job***, as recited in independent claims 21 and 35, respectively.

As none of the cited art, individually or in combination, discloses or suggests at least the above-noted features of independent claims 1, 18, 21 and 35, Applicant submits the inventions defined by claims 1, 18, 21 and 35, and all claims depending therefrom, are not rendered obvious by the asserted references for at least the reasons stated above.[32]

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

Dated: March 25, 2008

Respectfully submitted,

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[32] MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest **all** the claim limitations.

APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/878,962

1. A method of processing information with a system provided with a plurality of processing devices coupled to a network, the method comprising:

receiving a definition of a job for processing information from a user of the system;

automatically checking whether all processing devices belonging to a predetermined set selected from the plurality of processing devices are suitable for performing the job;

presenting an indication for each processing device of the set, to the user via presentation means, of whether the same is suitable for performing the job;

if a processing device among the processing devices belonging to the set is not suitable for performing the job, then a reason for this is indicated via the presentation means;

after that, selecting a processing device out of all processing devices belonging to the set, wherein the processing device not suitable for the job is selectable to become the selected processing device; and

transmitting at least a part of the job to the selected processing device.

2. The method according to claim 1, wherein the plurality of processing devices are printing devices.

3. (Canceled)

4. The method according to claim 1, wherein the indication of the reason that the processing device is not suitable for performing the job is made in response to said processing device having been selected by the user.

5. The method according to claim 1, wherein a part of the defined job is presented to the user.

6. The method according to claim 5, wherein said part of the job comprises a setting of the job.

7. The method according to claim 5, wherein said part of the job is presented to the user simultaneously with said indication the processing devices of the set via the presentation means.

8. The method according to claim 1, wherein the selected processing device is indicated on the presentation means

9. The method according to claim 8, wherein after a confirmation of the selection of the processing device, the job is passed to the selected processing device.

10. The method according to claim 9, wherein the confirmation of the selection is received from the user of the system.

11. The method according to claim 1, wherein a prediction as to what will be the selected processing device is predicted by the system on the basis of a predetermined criterion, after which the a change from the predicted selection can be received from the user.

12. The method according to claim 11, wherein the criterion is a processing property of the processing device.

13. The method according to claim 11, wherein the criterion is a distance between the user and the processing device.

14. The method according to claim 11, wherein the criterion is availability of the processing device.

15. The method according to claim 11, wherein the criterion is processing cost.

16. The method according to claim 11, wherein the criterion is a previously indicated personal preference of the user.

17. The method according to claim 1, further comprising indicating via the presentation means separately whether at least one processing device belonging to the set is suitable for performing the job.

18. A method of processing information with a system comprising one processing device and presentation means, the method comprising:

receiving a definition of a job for processing information from a user of the system;

automatically checking whether the processing device is suitable for performing the job;

indicating, if the processing device is not suitable for performing the job, a reason why the processing device is not suitable for performing the job via the presentation means; and

after that, selecting the processing device, wherein the processing device not suitable for the job is selectable to become the selected processing device for performing the job.

19. The method according to claim 18, wherein the reason is indicated if the processing device is allocated by a user of the system.

20. The method according to claim 18, wherein the processing device is a printing device.

21. A system for processing information, the system comprising:

a network to which are coupled the following;

a plurality of processing devices;

defining means for defining a job for processing information;

research means for checking whether all processing devices belonging to a predetermined set selected from the plurality of processing devices are suitable for performing the defined job;

presentation means for presenting an indication, for each processing device of the set, of whether the same is suitable for performing the defined job, and if a processing device among the processing devices belonging to the set is not suitable for performing the job, indicating why said processing device is not suitable; and

selection means for selecting a processing device out of all processing devices belonging to the set based on the indication, wherein the processing device not suitable for the job is selectable to become the selected processing device.

22. The system according to claim 21, further comprising first indicating means to indicate, in the event that the research means has determined that a displayed processing device is not suitable for performing the job, why said processing device is not suitable for performing the job.

23. (Canceled)

24. The system according to claim 22, further comprising allocating means for allocating a processing device, said allocating means being connected to the display means in such manner that in response to the allocation of the processing device the indicating means indicate why this processing device is not suitable.

25. The system according to claim 24, wherein the allocation means are controllable by a user of the system.

26. The system according to claim 21, further comprising means for displaying a part of the job.

27. The system according to claim 26, wherein said part comprises a setting of the job.

28. The system according to claim 26, wherein the means for displaying a part of the job is connected to the presentation means for presenting the said part to the user via the said presentation means.

29. The system according to claim 26, wherein the presentation means is adapted to present the said part of the job and the set of processing devices simultaneously.

30. The system according to claim 21, wherein the selection means are adapted to make a selection for a processing device on the basis of a predetermined criterion.

31. The system according to claim 30, wherein the criterion is selected from the group consisting of processing properties of the processing device, a distance between a user and the processing device, availability of the processing device, printing costs and a personal preference of the user.

32. The system according to claim 30, further comprising means with which a user of the system can change the selection.

33. The system according to claim 21, further comprising confirmation means connected to transmission means so that after confirmation of the selection of the processing device the job is transmitted to said selected processing device.

34. The system according to claim 21, further comprising second indicating means to indicate whether at least one processing device belonging to the set is suitable for performing the job.

35. A system for processing information, the system comprising:

a processing device;

defining means for defining a job for processing information;

research means for checking whether the processing device is suitable for performing the defined job; and

indicating means to indicate a reason, in the event that the research means shows that the processing device is not suitable for performing the job, why said processing device is not suitable for performing the job, wherein the processing device not suitable for the job is selectable to become a selected processing device for performing the job.

36. The system according to claim 35, further comprising allocation means for allocating the processing device in such manner that the indicating means indicates why the processing device is not suitable if the same has been allocated by the allocation means.

37. The system according to claim 35, wherein the processing device is a printing device.

38. A computer program element comprising computer program code means for causing a processor to perform the method according to claim 1.

39. A computer program element comprising computer program code means for causing a processor to perform the method according to claim 18.

40. The method according to claim 18, wherein the processing device not suitable for performing the defined job becomes selectable by the user to perform the defined job, after the indicating step.

41. The system according to claim 21, wherein the processing device not suitable for performing the defined job becomes selectable by a user to perform the defined job, after the

presentation means indicates why said processing device is not suitable for performing the defined job.

42. The system according to claim 35, wherein the processing device not suitable for the defined job becomes selectable by a user to perform the defined job, after the indicating means indicates why said processing device is not suitable for performing the defined job.

43. The system according to claim 21, wherein at least one of the plurality of processing devices is an inkjet printer.

APPENDIX B

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

APPENDIX C

No related proceedings are referenced in II. above, hence copies of decisions in related proceedings are not provided.